

## REMARKS

In response to the Office Action of June 5, 2003, Applicants have amended the claims which, when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration of all pending claims is respectfully requested.

In the Office Action of June 5, 2003, the Examiner has made final the previously-issued restriction requirement. Thus, claims 5, 6, 14 and 16-30 have been withdrawn from further consideration.

Claims 1-3 and 7, 8, and 10-11 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by DE 4015851. DE 401581 has been cited by the Examiner for its alleged teaching of "the same substrate in example 1" and also for advantages of employing the use of well known mutants which interrupt the beta-oxidation pathway. The reference has been additionally cited for its alleged teaching of employment of an organic solvent prior to fermentation. Example 1 of DE 4015851 teaches the use of either 2-octyldodecanol or 2-hexyldecanol for use as a substrate.

In response to the rejection, and in order to advance prosecution of this application, claims 1 and 11 have been amended. Applicant reserves the right to prosecute any subject matter deleted from claims 1 and 11 in one or more continuation applications. Claim 1 is presently amended to delete the recitation of "saturated primary alcohol." Claim 11, which depends from claim 1, is presently amended so that 1-dodecanol, 2-hexyldecanol, 2-butyl-1-octanol, and 1,2-hexadecanediol are no longer recited. Claim 12 has been amended to additionally recite "dodecanol" and "1,2-hexadecanediol." In view of the amendments to claims 1 and 11, withdrawal of the rejection of claims 1-3, 7, 8, and 10-11 under 35 U.S.C. § 102(b) is therefore warranted.

Claims 12 and 15 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Liu et al. (1993) *Biological Abstracts* 233484. The Liu et al. reference has been cited for its alleged teaching of the production of a carboxylic acid employing dodecene as the substrate. As presently amended, claim 12 no longer recites dodecene. Claim 15 depends from claim 12. In view of the amendment to claim 12, withdrawal of the rejection of claims 12 and 15 under 35 U.S.C. § 102(b) is respectfully requested.

Claims 4, 9, and 13 have been rejected under 35 U.S.C. § 103(a) as allegedly obvious over DE 4015851 or Liu et al. (1993) further in view of U.S. Patent Nos. 5,620,878 or 5,648,247. The Examiner's position is that it would have been obvious to employ the stains disclosed by U.S. Patent Nos. 6,004,784 or 6,228,275 for those of DE 4015851 or Liu et al. as well as adding a solvent in view of the teaching of U.S. 6,288,275. It is respectfully submitted that it is not clear from the office action whether U.S. Patent Nos. 5,620,878 and 5,648,247 are part of the rejection or if only U.S. Patent Nos. 6,004,784 and 6,288,275 are cited in the obviousness rejection.

Applicants respectfully submit that claim 4 depends from claim 3, which depends from claim 2, which depends from claim 1. Claim 9 also ultimately depends from claim 1. As presently amended, claim 1 no longer recites "saturated primary alcohol." Neither DE 4015851 nor Liu et al. teach or suggest a process for producing a carboxylic acid comprising culturing *Candida sp.* in a fermentation medium containing a substrate of the formula  $R(CH_2)_nCH_3$ , wherein  $n$  is 1 and  $R$  is selected from the group consisting of epoxide, alkoxy, ether, cycloalkyl, aryl, diol and diol ester, whereby at least one terminal methyl group is oxidized to a carboxylic acid corresponding to the substrate.

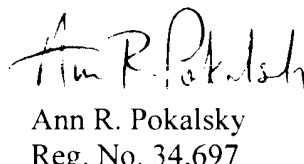
Claim 13 depends from claim 12. Neither DE 4015851 nor Liu et al. teach or suggest a process for producing a carboxylic acid comprising culturing *Candida sp.* in a

fermentation medium containing a substrate selected from the group consisting of 12-hydroxystearic acid, hexadecyl pelargonate, castor oil, hexadecyl acetate, dodecanol, 1,2-hexadecanediol, tetradecene, hexadecane, octadecene, trans-2-nonene, 7-trans-tetradecene, 2-heptylundecanoic acid and 2-hexyldecanoic acid whereby at least one terminal methyl group is oxidized to a carboxylic acid corresponding to the substrate, as presently recited in claim 12.

It is further respectfully submitted that the teachings provided by U.S. Patent Nos. 5,620,878 or 5,648,247 cannot ameliorate the deficiency of teachings provided by the primary reference, DE 4015851 or Liu et al. Nor can the teachings of U.S. Patent No. 5,620,878 or 5,648,247 ameliorate the deficiency of teachings provided by the primary reference. Absent a suggestion in the combination of references cited for the processes presently recited in claims 4, 9, and 13, the invention recited therein is not obvious. Withdrawal of the rejection of claims 4, 9, and 13 under 35 U.S.C. § 103(a) is therefore respectfully requested.

In view of the foregoing remarks and amendments, it is firmly believed that the present claims are in conditions for allowance, which action is earnestly solicited.

Respectfully submitted,



Ann R. Pokalsky  
Reg. No. 34,697  
Attorney for Applicants

DILWORTH & BARRESE  
333 Earle Ovington Blvd.  
Uniondale, NY 11553  
(516) 228-8484  
ARP/bg